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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,656	11/24/2001	Peter Klug	2000DE443	5306
25255	7590	03/24/2004	EXAMINER	
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/003,656	<b>Applicant(s)</b> KLUG ET AL.	
	<b>Examiner</b> Lauren Q Wells	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.  
2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,10 and 20-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3,10 and 20-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 3, 10, 20-24 are pending. The Amendment filed 11/3/03, cancelled claims 14-15, and 18, and amended claims 3, 10, and 20-21.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/24/03 has been entered.

#### ***Information Disclosure Statement***

The information disclosure statement filed 7/24/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of EP 0680946, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of EP 0680946, which is not in the English language. The information referred to therein has not been considered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 10, 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 10 is vague and indefinite, as it is confusing. In line 7, the claim recites, "is obtained by reaction of an alkenylsuccininc anhydride with a mono- and/or polyfunctional alcohol". Does this recitation refer to the alkenylsuccininc anhydride of formula (I) or to any alkenylsuccinic anhydride? This rejection can be overcome by incorporating the phrase "of formula (1)" following "an alkenylsuccininc anhydride" in line 7. Additionally, in line 6, what is "the ester of alkenylsuccininc". Does Applicant mean "the ester of alkenylsuccininc anhydride"?

The Examiner respectfully suggests that in claim 3, line 3, Applicant insert the term "of" between the term "mixture" and "isobutene".

***Claim Rejections - 35 USC § 103***

Claims 3, 10, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eierdanz et al. (5,650,158) in view of Carey et al. (XP-002950021) and in view of The Handbook of Cosmetic Science and Technology.

The instant claims are directed toward a composition comprising a fragrance and an emulsifier, wherein the emulsifier comprises an ester of an alkenylsuccininc anhydride of formula (1), wherein the ester is obtained by reaction of the alkenylsuccininc anhydride with a ethoxylated monoalcohol, propoxylated monoalcohol, fatty alcohol ethoxylate, methyl glycol, methyltriglycol, and mixtures thereof.

Eierdanz et al. teach skin-conditioning compositions containing succininc acid derivatives, see title. Col. 1, line 64-Col. 2, line 53, teach a succininc anhydride that is reacted with an alcohol of the formula R'-OH to form a monoester, wherein the monoester is then alkoxyated with ethylene oxide or propylene oxide, wherein the monoester or the alkoxyate may be hydrogenated to saturate any double bonds present. Stearyl, arachidyl, behenyl, oleyl,

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linoleyl, and erucic alcohol are taught as preferred R'-OH's, wherein these alcohols are fatty alcohols. It is respectfully pointed out that the alkoxylation of these fatty alcohols with ethylene oxide, results in a fatty alcohol ethoxylate, as recited in the instant claims. R2 and R3 of the succinic anhydride of Col. 1, line 64-Col. 2, line 53, is taught, wherein one of R2 and R3 is hydrogen and the other is an alkenyl group containing 12-22 carbon atoms. Col. 3, line 4 teaches the succinic acid derivative as comprising 1-10% of the composition. Exemplified is a method of making the anhydride with a ratio of 2 moles of the alcohol to 1.7 moles of the anhydride, which meets the instantly claimed ratios, see Col. 3, lines 20-49. Water-in-oil skin creams and lotions are exemplified as preferred cosmetic forms of the compositions, see Col. 6, line 34-Col. 7, line 11. The reference lacks polyisobutylene as the tail of the succinic anhydride, and perfumes.

Carey et al. teach improved high internal phase water-in-oil emulsions using alkenyl succinic anhydride based emulsifiers, see title. The emulsions are taught for personal care products for the skin and hair, see abstract and introduction. For the alkenylsuccinic anhydride of formula (1) of the instant claims, see the boxes on the 2<sup>nd</sup> and 3<sup>rd</sup> pages of the reference, wherein the tail is taught and exemplified to be a polyisobutylene chain. The last paragraph of page 2 teaches that polyisobutylene has been found to be an excellent choice for the tail as its high level of branching provides a high hydrodynamic volume to reduce coalescence of droplets leading to poor emulsion stability. The box on page 2 of the reference teaches A and B as an ester, salt or amide.

The Handbook of Cosmetic Science and Technology teaches that fragrances are used in almost all types of cosmetic and toiletry products and are included to enhance use characteristics

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and convey or support the marketing concept or brand image to the end-user. See pages 348-351.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach R2 of the succinic anhydride of Col. 2 of Eierdanz et al. as a polyisobutylene chain, as taught by Carey et al. to achieve the alkenylsuccinic anhydride of formula (1) of the instant claims, because Eierdanz et al. teach R2 as an alkenyl chain and because of the expectation of achieving a compound that provides a high hydrodynamic volume to reduce coalescence of droplets in water-in-oil emulsions, thereby increasing stability of the compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a fragrance, as taught by the Cosmetic Handbook of Science and Technology, to the compositions of Eierdanz et al. because of the expectation of achieving a product with enhanced use characteristics, wherein the product conveys a marketing concept or brand image to the end-user.

The Examiner respectfully points out instant claims are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Thus, the ratio of anhydride to alcohol and the polymerization to achieve the

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polyisobutylene chain are not given patentable weight, since the products of the prior art and those recited in the instant claims are the same.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**